

REMARKS

Applicant proposes to cancel independent claim 51 and claims 52 through 57 depending therefrom. The remaining claims are not amended herein.

Independent claims 1 and 27 stand rejected under §103(a) as obvious over Moskowitz '002 in view of Holda-Fleck '693, as set forth in section 2 of the Final Office Action.

In the Advisory Action, the Examiner stated that the arguments set forth in applicant's previous submission are not persuasive because:

KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness.

Applicant fully appreciates the import of the *KSR* decision. However, *KSR* did not eliminate the requirement that an obviousness combination must be based on some reasonable and logical reason to make the combination or modification suggested in the rejection. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a reasonable factual basis to support the legal conclusion of obviousness. See *In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). This fundamental principal was not eliminated by *KSR*. In fact, *KSR* expressly emphasizes this point. ***“There must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’... [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”*** *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). *KSR* reiterates the standard set long

ago by the CCPA wherein it was held that even if all elements of a claim are disclosed in various prior art references, the claimed invention taken as a whole cannot be said to be obvious ***without some reason given in the prior art why one of ordinary skill would have been prompted to modify the teachings of the references to arrive at the claimed invention.*** See *In re Regel*, 188 U.S.P.Q. 132 (C.C.P.A. 1975).

In a recent published precedential opinion, the BPAI in *In re Whalen II*, Slip Op. 2007-4423 (BPAI July 23, 2008) reversed the Examiner on obviousness because the Examiner had not “pointed to any teaching in the cited references, or provided any explanation based on scientific reasoning,” to support the conclusion of obviousness. Discussing *KSR*, the Board stated (Slip Op. at 15-16):

The U.S. Supreme Court recently held that rigid and mandatory application of the “teaching-suggestion-motivation,” or TSM, test is incompatible with its precedents. [citing *KSR*] The Court did not, however, discard the TSM test completely; it noted that its precedents show that an invention “composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” The Court held that the TSM test must be applied flexibly, and take into account a number of factors “in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed.” Despite this flexibility, however, the Court stated that “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements in the way the claimed new invention does.” [citations to *KSR* omitted]

Accordingly, even if all elements of a claim are disclosed in various prior art references, the claimed invention taken as a whole cannot be said to be obvious without some “***articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.***” *KSR*.

The subject matter of Moskowitz '002 and Holda-Fleck '693 are so fundamentally different that one skilled in the art would have no motivation “***or logical reason***” to modify the method and system of Moskowitz '002 with the system of Holda-Fleck '693.

There is simply no logical or other well-founded reason to modify the reference as suggested by the Examiner (i.e., “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). Such reasoning cannot be garnered only after reading the present application.

The system and method of Moskowitz '002 are concerned with enticing a customer to fill out and complete a product evaluation form. Part of the enticement may be a reward or "rebate" in the form of cash or non-cash value. It is important to understand that this reward ***is not a manufacturer's rebate that attaches automatically to the purchase of a product.*** The reward is an enticement and is conditional upon the customer actually completing an evaluation form. ***The customer is not entitled to any type of rebate or reward simply because they purchase the product.***

Thus, the system and methodology of Moskowitz have nothing to do with a manufacturer's rebate process, and there is no rationale or logical reason for the Moskowitz '002 system to be modified to process and validate a manufacturer's rebate claim that is dependent solely on purchase of the product. Such a rebate is simply not a concern or a component of the system and methodology of Moskowitz '002. For example, there is no reason or rationale in Moskowitz '002 to check a database to even see if a rebate attaches to a product. There is no reason or rationale to inform a purchasing customer of the status of any manufacturer's rebate claim, and so forth. As emphasized above, with the system and methodology of Moskowitz '002, the "rebate" is an automatic reward to entice a customer to complete an evaluation form, and is triggered automatically if the customer completes the form.

Respectfully, the Examiner has not provided the equivalent of an “articulated reasoning with rational underpinning” as to why one skilled in the art would modify the Moskowitz '002 system to include an independent rebate system wherein a manufacturer's rebate claim is made, rebate claim information is gathered, processed, and validated, and wherein claim status information is conveyed back to a different computer to be presented to the customer. Moskowitz '002 has no relevance to such a system.

In addition, the Examiner has not addressed the fact that, even if the modification/combination suggested by the Examiner were to be made, ***the resulting configuration is still not in accordance with independent claims 1 and 27.*** As acknowledged by the Examiner, Moskowitz '002 does not include the configuration of a first computer in communication with an electronic reading device to retrieve product-identification-information stored in an electronic tag associated with a product being purchased, with the first computer configured to use the information to acquire rebate-claim-information. The system of Moskowitz '002 does not include a first computer configured to communicate with a second computer so as to transfer to the second computer the rebate-claim-information substantially contemporaneous with the purchase, wherein the second computer is configured to process and validate a rebate claim with the information, and to transfer the rebate claim status information to the first computer, which communicates the information to the customer. The Examiner proposes that Holda-Fleck '693 discloses the first and second computer configurations.

With the system of Holda-Fleck '693, a first computer database is used to verify the validity of a product code that is input into the system via a telephone by the

consumer. This computer is not in communication with any type of electronic reading device to retrieve product information stored in an electronic tag associated with the product. With the system of Holda-Fleck '693, the first computer determines if a rebate actually exists for the product by referencing the product code to a particular manufacturer of the product to see if a rebate exists. If the product code is verified, the purchaser is then prompted to enter a serial number that is unique to the particular product being purchased. A second computer is used to verify the serial number by referencing the serial number with a database to determine if the particular product has already been presented for a rebate. If the product has been presented, the telephone call with the consumer is terminated. If the product code and the serial codes are verified, the consumer is credited with the rebate amount corresponding to the product code.

It should thus be appreciated that the first and second computers in the configuration of Holda-Fleck '693 are simply used to perform separate processing or validation steps related to the product code and serial number, respectively. ***The second computer does not process and validate the serial number of a particular product with any type of information that is communicated to the second computer by the first computer, with the first computer acquiring the information from an electronic reading device.*** Both of the computers in the Holda-Fleck system process the product code or serial number that is input into the computer by the consumer via a telephone line. In addition, the second computer does not transfer the status or information from its serial number verification process back to the computer

that verified the product code, with the first computer then communicating the information back to the customer.


Accordingly, the modification proposed by the Examiner to Moskowitz '002 in view of Holda-Fleck '693 does not result in a system and methodology that satisfies the method of claim 27 or system of claim 1. The Examiner is respectfully requested to address this noted deficiency with particularity. Such explanation will serve both the Applicant and the Examiner in the appeal process.

With the present amendment to cancel claims 51 through 57, applicant respectfully submits that all of the remaining claims (unamended herein) patentably distinguish over the cited combination of references, and are allowable. It is respectfully submitted that the application is in condition for allowance, and favorable action thereon is respectfully requested.

The Examiner is encouraged to contact the undersigned at his convenience should he have any questions regarding this matter or require any additional information.

Respectfully submitted,

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